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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,766	09/25/2003	Fernando Dangond	PART:005US	2785

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EXAMINER

HAMA, JOANNE

ART UNIT PAPER NUMBER

1632

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/670,766	Applicant(s) DANGOND ET AL.	
	Examiner Joanne Hama, Ph.D.	Art Unit 1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-56 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

This Application was filed September 26, 2003 and claims benefit of 60/414,219 filed September 27, 2002.

Claims 1-56 are pending.

The election to the previous Restriction Requirement, filed February 11, 2005, has been acknowledged. However, upon further examination, it was determined that further restriction was needed. Accordingly, the restriction of December 8, 2004 has been vacated.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Set I. Claims 1- 24, 48, 51 drawn to a method for treating or preventing multiple sclerosis (MS) comprising administering to a subject with MS a composition that causes an increase in the activity or expression of at least one gene product from a list specified by the Applicant, classified in class 514, subclass 1+.

Set II. Claims 25-46, 49, 52-56, drawn to a method for treating or preventing multiple sclerosis (MS) comprising administering to a subject with MS a composition that causes a decrease in the activity or expression of at least one gene product from a list specified by the Applicant, classified in class 514, subclass 1+.

Set III. Claim 50, drawn to a method of identifying a composition useful in the treatment or prevention of multiple sclerosis (MS), classified in class 424, subclass 9.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Sets I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). While Inventions of Sets I and II are to a method for treating or preventing multiple sclerosis comprising administering to a subject with MS a composition, an Invention of Set I is to a composition that causes an increase in the activity or expression of at least one gene product and an Invention of Set II is to a composition that causes a decrease in the activity or expression of at least one gene product. An invention of Set I does not depend on an Invention of Set II to function and vice versa.

Inventions of Sets I/II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). An invention of Sets I/II is to a method of treating or preventing multiple sclerosis (MS) comprising administering a composition. An Invention of Set III is to a method of identifying a composition useful in the treatment or prevention of multiple sclerosis (MS). An Invention of Sets I/II do not depend on an Invention of Set III to function and vice versa.

It is noted that Inventions I, II, and III are drawn to a plurality of genes. Each gene is patentably distinct as each gene encodes a protein that has different structure,

function, and bioactivity. It is noted that Inventions of Sets I and II encompass specific combinations of genes. It is required that the Applicant selects one gene or a specific combination of genes that is readable on the claims. This is a restriction and not a species election. Applicant is reminded to elect a gene or specific combination of genes as no election was made in the previous Restriction Requirement.

Applicant is advised that a reply to this requirement must include an identification of the gene or specific combination of genes that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, that the search for one Invention is not required for the search of another invention, and are divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Hama, Ph.D. whose telephone number is 571-272-2911. The examiner can normally be reached Monday through Thursday and alternate Fridays from 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, Ph.D. can be reached on 571-272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has

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been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

JH



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SUPERVISORY PATENT EXAMINER